

REMARKS

The courtesy of Examiner Katcheves in granting an interview to the applicant's attorney is gratefully acknowledged.

During the interview, the Examiner stated that the engagement of the screen element disclosed in the application is not "self-releasable", because an opening force must be applied to the window of the application in order for the screen element to release. By the present Amendment, independent claim 18 has been amended to recite with greater particularity the feature of the releasable nature of the screening element. More specifically, claim 18 has been amended to recite "wherein said at least one screening element releases from engagement with the corresponding frame or sash member in response to said sash being moved beyond the ventilating position in a direction away from the closed position". As can be appreciated from, for example, Figs. 2 and 5 and page 14, lines 5-14 of the specification, the screening element only covers the opening between the sash and frame up to a limited opening angle of the sash, i.e. in a ventilating position of the window, whereas the screening element disengages from one of the frame or sash members when the opening angle of the sash exceeds this limited opening angle.

This feature is not disclosed, either explicitly or inherently, in the Persson reference. Persson does not contemplate even an open position of the sash in which the screen members do not extend all the way from the frame to the sash. Regardless how far open the sash of Persson moves, the screen members extend to remain in engagement with the sash and the frame. For at least this reason, Persson does not disclose at least one screening element that releases from engagement with the corresponding frame or sash member in response to the sash being moved beyond a ventilating position in a direction away from the closed position.

Also during the interview, the Examiner referred to the releasable engagement feature as being functional. With respect to “functional”, in *In re Swinehart*, 169 U.S.P.Q. 226 (CCPA 1971), the court said “We take the characterization “functional”, as used by the Patent Office and argued by the parties, to indicate nothing more than the fact that an attempt is being made to define something ... by what it does rather than by what it is (as evidenced by specific structure or material, for example). In our view, there is nothing intrinsically wrong with the use of such a technique in drafting patent claims. Indeed we have even recognized in the past the practical necessity for the use of functional language.”

The feature of the at least one screening element releasing from engagement with the corresponding frame or sash member in response to said sash being moved beyond the ventilating position in a direction away from the closed position is not disclosed, either explicitly or inherently, in the Persson reference. Accordingly, the Persson reference does not anticipate claim 18 as presently amended. Furthermore, nothing in the prior art would have rendered obvious a position of the sash of the Persson reference beyond positions in which the screening elements are attached to both the sash and the frame, and nothing in the prior art would have rendered obvious the at least one screening element of the Persson reference releasing from engagement with the corresponding frame or sash member in response to said sash being moved beyond a particular position.

In addition, reconsideration of the rejection of claims 20-23, 29 and 36 under 35 USC 103 as being unpatentable over Persson in view of MacDonald is respectfully requested. A person of ordinary skill would not have looked at those two references and thought that it would have been obvious to replace one of the roller screen elements of Persson with the shelf member 5 of MacDonald at all, unless the person already knew about the present invention. Even when

using hindsight based on prior knowledge of the present invention, such a modification of Persson is difficult to imagine and would result in an awkward arrangement, and it is not clear how it would operate.

Furthermore, such a combination of Persson and MacDonald would not have at least one of the features of claim 23. Specifically, such a combination of Persson and MacDonald would not have at least one screening element connected with the sash or frame top or bottom member, wherein said flap is preloaded towards the active position of the screening element by means of a tensioning element. The flap of MacDonald is not preloaded by a tensioning element.

With respect to claim 29, there is a sloped window sill 9 in MacDonald. Such a feature is common to provide drainage. The same would not be true of a sloped window frame at the top. Thus, such a modification is not a mere duplication of parts and would not have been obvious. With respect to claim 36, the Examiner contends that the element 3 of Persson is a coiled spring. However, Persson describes the element 3 as a roller on which a screen member 6 is wound. Furthermore, in the Examiner's combination of Persson and MacDonald, the screen member 6 would be replaced by the shelf 5 of MacDonald.

A new independent claim 37 is presented that is like claim 18 except that claim 37 recites said at least one screening element is adapted to release from engagement with the corresponding frame or sash member in response to said sash being moved beyond the ventilating position in a direction away from the closed position. It is submitted that claim 37 is allowable for the same reasons that claim 18 is allowable. It is pointed out that "adapted to" imparts a structural limitation to a claim and that such a limitation must be considered. In this regard, the applicant points to *In re Venezia*, 189 USPQ 149 (CCPA 1976), in which the court referred to the claim language "a pair of sleeves *** each sleeve of said pair *adapted to be fitted* over the insulating

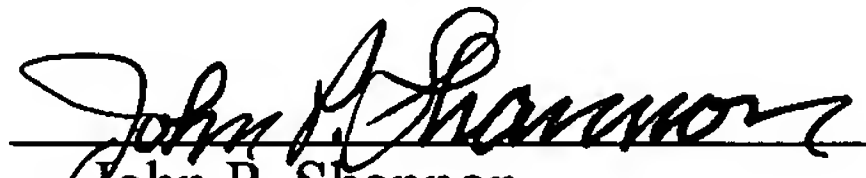
jacket of one of said cables” and stated: “Rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensioned that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to the “adapted to be affixed” and “adapted to be positioned limitations” of the third and fourth paragraphs of the claim.”

In view of the foregoing, it is submitted that all of the claims are allowable and that the application is in condition for allowance. An early notice to that effect is respectfully requested.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney’s Deposit Account No. 50-0562.

Respectfully submitted,

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